

ESTTA Tracking number: **ESTTA486286**

Filing date: **07/30/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205699
Party	Defendant Rock Creek Global Advisors LLC
Correspondence Address	JULIA M CHESTER SIDLEY AUSTIN LLP 717 N HARWOOD, STE 3400 DALLAS, TX 75201 UNITED STATES
Submission	Answer
Filer's Name	Julia M. Chester
Filer's e-mail	jchester@sidley.com,robrien@sidley.com
Signature	/Julia M. Chester/
Date	07/30/2012
Attachments	Applicant's Answer.pdf (7 pages)(347668 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

The Rock Creek Group, LP,)	
)	
Opposer,)	
v.)	Opposition No.: 91205699
)	Serial No. 85/433,339
Rock Creek Global Advisors LLC,)	
)	
Applicant)	
_____)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Rock Creek Global Advisors LLC ("Applicant"), a Delaware limited liability company having a principal place of business at 1401 I Street, NW, Suite 1120, Washington, D.C. 20005, the owner of U.S. Application Serial No. 85/433339 ("Applicant's Mark"), for its Answer to the Notice of Opposition filed by the Rock Creek Group, LP ("Opposer"), states as follows:

1. **Opposer's Allegation:** Applicant seeks registration on the Principal Register of the trademark "ROCK CREEK GLOBAL ADVISORS LLC & Design" for use in connection with business consulting services, namely, consulting for persons, businesses and governments in the fields of national and international economic and regulatory policy, cross-border transactions, and strategic business alliances, all for support of global business operations, as evidenced by the publication of said trademark in the May 22, 2012 issue of the Official Gazette.

Applicant's Response: Applicant admits the allegations in Paragraph 1.

2. **Opposer's Allegation:** Rock Creek Group is now, and has been for some time, engaged in financial management, asset management, investment and local and global advisory services to large national and international institutional investors, including sovereign wealth funds, state and local pension plans, corporations, foundations and endowments. Rock Creek Group has built a successful, Washington D.C.-based asset management and advisory business. Rock Creek Group's client base is comprised exclusively of major institutions spanning the public, private and nonprofit sectors in North America,

Asia and Europe. All of these clients are affected by global financial and economic developments and by the policy decisions taken in Washington, D.C. in the federal government and in major international financial institutions such as the World Bank and the IMF. These clients engage Rock Creek Group's services in substantial part because its personnel have extensive experience in these matters and can provide policy and strategy advice in addition to the services of an SEC-registered investment adviser. Rock Creek Group provides clients with strategic advice on a broad array of economic and policy issues alongside its suite of asset management services. As a result, there is substantial overlap in the pool of existing and potential clients with that of the Applicant

Applicant's Response: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2.

3. **Opposer's Allegation:** To provide its global financial management, asset management and advisory services, Rock Creek Group is a registered SEC advisor and utilizes many former World Bank senior officers and directors to provide its services to its clients.

Applicant's Response: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3.

4. **Opposer's Allegation:** Rock Creek Group adopted the mark "THE ROCK CREEK GROUP" in connection with the services set forth in Paragraph 2 since at least as early as January 2003, and has been using the mark in connection with those services ever since. Such use has been valid and continuous since the date of first use and has not been abandoned.

Applicant's Response: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4.

5. **Opposer's Allegation:** Rock Creek Group is the owner of pending United States trademark application Serial No. 85/595470 for the mark "THE ROCK CREEK GROUP" for use in connection with financial services, namely, financial management services, investment management services, investment advisory services, asset portfolio management services, securities trading services, creating portfolios of emerging fund managers for investors, developing customized portfolio solutions,

providing dynamic asset allocation services, providing risk budgeting, risk aggregation and risk management services, conducting fund, manager investment and operational due diligence, transition management services for investors restructuring portfolios and providing temporary use of non-downloadable computer programs, databases and analytical tools for use in investment and asset management, asset and risk allocation, fund and manager due diligence, portfolio construction, risk measurement, operations and investor communications, based upon use of the mark since at least as early as January 2003.

Applicant's Response: Applicant admits that Rock Creek Group is the named Applicant in pending United States trademark application Serial No. 85/595470 for the mark "THE ROCK CREEK GROUP." Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 5.

6. **Opposer's Allegation:** Rock Creek Group's mark "THE ROCK CREEK GROUP" is symbolic of the extensive goodwill and recognition built up by Rock Creek Group through continuous use of said mark over a substantial period of time.

Applicant's Response: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6.

7. **Opposer's Allegation:** Rock Creek Group has expended considerable effort and expense in promoting its mark "THE ROCK CREEK GROUP" and the services provided under such mark, with the result that the relevant public has come to know, rely upon and recognize the services of Rock Creek Group by such mark. Rock Creek Group has exceedingly valuable goodwill established in its mark.

Applicant's Response: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 7.

8. **Opposer's Allegation:** Application Serial No. 85/433339 for registration of the mark "ROCK CREEK GLOBAL ADVISORS LLC & Design" was filed on September 27, 2011 based upon Applicant's bona fide intent to use said mark. Subsequently, Applicant filed an Amendment to Allege Use of its mark, claiming a first use date of November 1, 2011. Thus, Rock Creek Group actually began using

its "THE ROCK CREEK GROUP" mark more than 8 years prior to the filing date of Applicant's application and the date Applicant began to use its mark.

Applicant's Response: Applicant admits that Application Serial No. 85/433339 for registration of "ROCK CREEK GLOBAL ADVISORS LLC & Design" was filed on September 27, 2011 based upon a bona fide intent to use the mark. Applicant admits that Applicant filed an Amendment to Allege Use of its mark, claiming a first use date of November 1, 2011. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 8.

9. **Opposer's Allegation:** Rock Creek Group's mark "THE ROCK CREEK GROUP" and Applicant's mark "ROCK CREEK GLOBAL ADVISORS LLC & Design" are virtually identical, given that the Applicant has entered a disclaimer of the term "GLOBAL ADVISORS LLC." The dominant terms in each mark are "ROCK CREEK."

Applicant's Response: Applicant admits that Applicant entered a disclaimer of the term "GLOBAL ADVISORS LLC." Applicant denies the remaining allegations of Paragraph 9.

10. **Opposer's Allegation:** The services which are identified in Rock Creek Group's application for its mark "THE ROCK CREEK GROUP" are closely related to the services identified in the Applicant's application to register "ROCK CREEK GLOBAL ADVISORS LLC & Design," and on information and belief, will be marketed through the same or similar channels of trade or to the same or similar class of consumers. The disclaimed portion of Applicant's mark ("GLOBAL ADVISORS") describes components of the services provided by the Rock Creek Group under its mark "THE ROCK CREEK GROUP," as the Rock Creek Group provides global advice to its clients.

Applicant's Response: Applicant denies the allegations of Paragraph 10.

11. **Opposer's Allegation:** The Rock Creek Group advisory board is comprised, among others, of academics, former Bank of England officials and a Pulitzer Prize winning financial historian. Such individuals are not asset managers, but rather are global international finance experts who regularly deal with sophisticated institutions and have delivered for Rock Creek Group clients services substantially

similar to the services listed in the Applicant's application. Such individuals are the type of people with which Applicant would want to be affiliated.

Applicant's Response: Applicant is without knowledge or information sufficient to form a belief as to the truth of the first two sentences of Paragraph 11. Applicant denies the allegations of the third sentence of Paragraph 11.

12. **Opposer's Allegation:** By reason of Rock Creek Group's extensive use of the "THE ROCK CREEK GROUP" mark, the public has believed and will believe that the Applicant's use of its mark "ROCK CREEK GLOBAL ADVISORS LLC & Design" is sponsored or approved by Rock Creek Group and that the quality of the services bearing the Applicant's mark has been approved and/or maintained by Rock Creek Group.

Applicant's Response: Applicant denies the allegations of Paragraph 12.

13. **Opposer's Allegation:** On information and belief, Applicant is not SEC-registered nor otherwise subjected to financial-sector regulatory oversight. The public has come to expect that services offered under Rock Creek Group's mark "THE ROCK CREEK GROUP" are provided within an institutional framework registered with, and overseen by, the SEC and other financial-sector regulators. Rock Creek Group has suffered harm and will continue to suffer harm if the public is confused that Applicant's services offered under its mark "ROCK CREEK GLOBAL ADVISORS LLC & Design" emanate from Rock Creek Group and are provided by international financial experts who are not under the purview of a regulatory body like the SEC.

Applicant's Response: Applicant admits it is not SEC-registered nor otherwise subjected to financial-sector regulatory oversight. Applicant is without knowledge or information sufficient to form a belief as to the truth of the second sentence of Paragraph 13. Applicant denies the allegations of the third sentence of Paragraph 13.

14. **Opposer's Allegation:** In view of these similarities, Applicant's use of the mark "ROCK CREEK GLOBAL ADVISORS LLC & Design" has caused confusion and is likely to continue to cause

confusion, mistake, or deception with respect to Rock Creek Group's mark "THE ROCK CREEK GROUP" and to damage the goodwill represented and symbolized by the mark.

Applicant's Response: Applicant denies the allegations of Paragraph 14.

15. **Opposer's Allegation:** Based on the foregoing, Applicant's registration of the mark "ROCK CREEK GLOBAL ADVISORS LLC & Design" on the Principal Register of the United States Patent and Trademark Office has caused and will clearly cause injury and damage to Rock Creek Group.

Applicant's Response: Applicant denies the allegations of Paragraph 15.

PRAYER FOR RELIEF – APPLICANT'S RESPONSE

17. Responding to Opposer's Prayer for Relief, Applicant denies that Opposer is entitled to any of the relief requested.

SEPARATE DEFENSES

18. Applicant states that Opposer will not be damaged by the registration of Applicant's Mark.

19. Applicant states that Applicant's mark is distinctively different in sight, sound meaning, connotation and commercial impression from Opposer's Mark.

20. Applicant states that Applicant's mark is used in different channels of trade from channels of trade in which Opposer's Mark is used.

21. Applicant states that the services provided under Applicant's Mark are different from the services provided under Opposer's Mark such that the relevant trade and public are not, and will not, likely confuse, nor mistake, the source or origin of the services provided under Applicant's Mark and the services provided under Opposer's Mark.

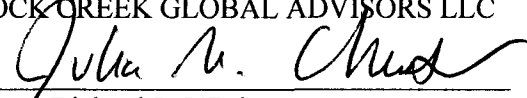
22. Applicant states that Opposer's Mark has not become inherently distinctive of Opposer's services, nor has Opposer's Mark acquired distinctiveness in connection with Opposer's services.

23. Applicant states that Opposer's mark is weak as it relates to Opposer's services provided under Opposer's Mark.

Applicant prays that the Board deny Opposer's request that its Opposition be sustained and deny Opposer's request that Applicant's Application be refused.

Date: July 30, 2012

ATTORNEYS FOR APPLICANT
ROCK CREEK GLOBAL ADVISORS LLC




Richard J. O'Brien
SIDLEY AUSTIN LLP

One South Dearborn Street
Chicago, Illinois 60603
Phone: (312) 853-7283
Fax: (312) 853-7036
Email: robrien@sidley.com

Julia M. Chester
SIDLEY AUSTIN LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Phone: (214) 981-3308
Fax: (214) 981-3400
Email: jchester@sidley.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Answer to Notice of Opposition has been served on Michael J. Bevilacqua, Esq. by delivering said copy via email to: Michael J. Bevilacqua, Wilmer Cutler Pickering Hale and Dorr LLP, 60 State Street, Boston, Massachusetts 02109 on this 30th day of July, 2012.



Julia M. Chester